

### **REMARKS**

In response to the Office Action dated 13 April 2004, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-23, 26 and 27 are pending in the application, and are rejected. Claims 1, 7, 11, 12, and 18 will be amended, and new claims 28-48 will be added, upon entry of the present amendment. No new matter has been added.

#### **New Claims**

New claims 28-48 will be added upon entry of the present amendment. No new matter has been added.

#### **Information Disclosure Statement**

The Information Disclosure Statement submitted herewith includes JP-2000231969 to Yaguchi, such that the full English translation of this document is made of record.

#### **Rejection of Claims Under §102**

Claims 1-3, 11, 12, 16 and 17 were rejected under 35 USC § 102(e) as being anticipated by Herwig (U.S. 6,701,192). The applicant respectfully traverses.

Herwig issued on 2 March 2004, which is after the filing date of the present application. The applicant does not admit that Herwig is prior art, and reserves the right to swear behind Herwig at a later date. However, the applicant believes Herwig is distinguishable from the claimed invention.

Amended claim 1 recites an apparatus, comprising, among other elements, a housing, a power supply enclosed in the housing, a bus hub enclosed in the housing, the power supply being coupled to the bus hub to supply power to the bus hub, and a downstream receptacle in the housing connected to both the power supply and the bus hub.

Herwig relates to a wiring hub for a retail terminal. Herwig, abstract. Herwig shows a wiring hub 100 including a housing 110, a USB hub interface 114, and a power supply 112. The power supply 112 is not coupled to the USB hub interface 114 of Herwig as is recited in

amended claim 1 because Herwig shows no connection from power supply 112 to USB hub interface 114 (see Fig. 3). The applicant respectfully submits that Herwig does not show all of the features recited in amended claim 1, and that amended claim 1 is in condition for allowance.

Claims 2-3 and 11 are dependent on amended claim 1, and recite further features with respect to amended claim 1. Amended claim 12, and claims 16 and 17 that are dependent on amended claim 12, recite features similar to those recited in amended claim 1. For reasons analogous to those stated above, and the features in the claims, the applicant respectfully submits that claims 2-3, 11, 12, 16 and 17 are not shown by Herwig, and that claims 2-3, 11, 12, 16 and 17 are in condition for allowance.

#### Rejections of Claims Under §103

Claims 4, 5, 19 and 20 were rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Universal Serial Bus Specification, Revision 1.1 (September 23, 1998). The applicant respectfully traverses.

The Office Action cites the Universal Serial Bus Specification, Revision 1.1, page 136, in support of this rejection. Office Action, page 4. The applicant respectfully submits that page 136 of the USB Specification is not of record and no copy of it was provided (see MPEP 707.05(a)). The applicant respectfully requests that the reference be made of record with a copy being provided to the applicant, or that the rejection be withdrawn.

The MPEP states the following with regard to rejections under 35 USC § 103: "To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." MPEP 2143. A Federal Circuit opinion states that the suggestion or motivation to combine references must be found in the prior art. MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In addition, the Federal Circuit, in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), requires that the suggestion or motivation to combine references "be based on objective evidence of record." The Federal Circuit also indicated that the suggestion or motivation must be specific. 61 USPQ2d at 1433.

The applicant respectfully submits that there is no evidence of a suggestion or motivation to modify Herwig. The Office Action states that “it would have been obvious.....to have included said self powered bus hub in said apparatus since it would provide the advantage of driving a plurality of ports, which are limited only by the address capability of said bus hub and the local power supply.” Office Action, page 4. The Office Action has not cited evidence of record in support of this motivation to modify Herwig as is required by *In re Vaeck*, and *In re Lee*. Furthermore, the applicant notes that Herwig has a priority date of 13 September 2000, well after the September 1998 publication of the USB Specification, Revision 1.1. Even though the USB Specification cited was available to Herwig, Herwig does not show the feature alleged to be “obvious” in the Office Action.

The applicant respectfully submits that a *prima facie* case of obviousness of claims 4, 5, 19 and 20 has not been established in the Office Action, and that claims 4, 5, 19 and 20 are in condition for allowance.

Claims 6 and 18 were rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Urade et al. (U.S. 6,272,644, Urade). The applicant respectfully traverses.

Claim 6 is dependent on amended claim 1, and recites further features with respect to amended claim 1. Amended claim 18 is dependent on amended claim 12, and recites further features with respect to amended claim 12. The applicant respectfully submits that Urade does not show a power supply being coupled to a bus hub to supply power to the bus hub as is recited in amended claims 1 and 12. Therefore, even as combined, Herwig and Urade do not show all of the features recited in claims 6 and 18.

The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 6 and 18, and that claims 6 and 18 are in condition for allowance.

Claim 7 was rejected under 35 USC § 103(a) as being unpatentable over Herwig, and further in view of Kang (U.S. 6,253,329). The applicant respectfully traverses.

Claim 7 is amended herein, and the subject matter recited in unamended claim 7 is now recited in amended claim 1.

Kang relates to a USB hub with a plurality of input power sources. Kang, title. Kang shows, in Figure 3, power supplied to a hub 400 from an upstream VBUS or a local power supply unit 300, both of which are external to the hub. The applicant respectfully submits that Kang does not show a power supply being coupled to a bus hub to supply power to the bus hub where both the power supply and the bus hub are in a housing as is recited in amended claim 1. Therefore, even as combined, Herwig and Kang do not show all of the features recited in amended claim 1.

Furthermore, the applicant respectfully submits that there is no evidence of a suggestion or motivation to combine Herwig with Kang. Kang states that:

“A circuit is constructed so that the user can select bus power or self-power as to the power source of the USB hub depending on the user’s necessity. As a result, it is not necessary for the user to purchase a bus power USB hub or a self-power USB hub separately. The user who employs the present invention can easily select a power source supply method which fits his use by simply adding a power source cable for self-power.” Kang, column 5, lines 28-35.

Kang and Herwig are clearly showing two different, unrelated devices. The USB hub of Kang is a consumer item, and it can run from two different power sources to give the consumer more options. Kang does not show a power supply inside its USB hub, and all power is supplied from sources outside the consumer device of Kang. The system of Herwig is a wiring hub for a retail terminal which would not be purchased or used by a consumer. The self-described advantage of Kang is not applicable to Herwig. One skilled in the art would not have been motivated to modify Herwig based on the showing of Kang. In fact, combining them would go against the teachings of one of them, because the desirable flexibility allowing use of Kang with separate power supplies “teaches away” from the apparatus in Herwig with its power supply and hub in the same enclosure.

The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of amended claim 7, and that amended claim 7 is in condition for allowance.

Claim 8 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Kang and Tsai (U.S. 6,283,789). The applicant respectfully traverses.

Claim 8 is dependent on amended claim 1, and recites further features with respect to amended claim 1. As stated above with respect to claim 7, Herwig and Kang together do not show a power supply being coupled to a bus hub to supply power to the bus hub where both the power supply and the bus hub are in a housing as is recited in amended claim 1. Tsai relates to a data and power transmitting cable system. Tsai, title. Tsai does not show a power supply being coupled to a bus hub as is recited in amended claim 1. Therefore, even as combined, Herwig, Kang, and Tsai do not show all of the features recited in claim 8.

In addition, the Office Action has not cited evidence of record in support of a motivation to combine Herwig, Kang, and Tsai as is required by *In re Vaeck*, and *In re Lee*. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claim 8, and that claim 8 is in condition for allowance.

Claim 9 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Kang, Tsai, and Decuir (U.S. 5,781,028). Claim 10 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Kang, Tsai, and Sanchez (U.S. 6,446,867). The applicant respectfully traverses.

Claims 9 and 10 are dependent on claim 8 which is dependent on amended claim 1, and recites further features with respect to amended claim 1. As stated above with respect to claim 8, Herwig, Kang, and Tsai together do not show a power supply being coupled to a bus hub to supply power to the bus hub where both the power supply and the bus hub are in a housing as is recited in amended claim 1. Decuir relates to data bus termination. Decuir, title. Sanchez relates to an electro-optic interface system. Sanchez, title. Neither Decuir nor Sanchez show a power supply being coupled to a bus hub as is recited in amended claim 1. Therefore, even as combined, Herwig, Kang, and Tsai combined with Decuir or Sanchez do not show all of the features recited in claims 9 and 10.

In addition, the Office Action has not cited evidence of record in support of a motivation to combine Herwig, Kang, and Tsai as is required by *In re Vaeck*, and *In re Lee*. The applicant

respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 9 and 10, and that claims 9 and 10 are in condition for allowance.

Claim 13 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Tsai. The applicant respectfully traverses.

Claim 13 is dependent on amended claim 12, and recites further features with respect to amended claim 12. As stated above with respect to amended claim 12, Herwig does not show a power supply being coupled to a bus hub to supply power to the bus hub as is recited in amended claim 12. Tsai does not show a power supply being coupled to a bus hub as is recited in amended claim 12. Therefore, even as combined, Herwig and Tsai do not show all of the features recited in claim 13.

In addition, the Office Action has not cited evidence of record in support of a motivation to combine Herwig and Tsai as is required by *In re Vaeck*, and *In re Lee*. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claim 13, and that claim 13 is in condition for allowance.

Claim 14 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Tsai and Decuir. Claim 15 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Tsai and Sanchez. The applicant respectfully traverses.

Claims 14 and 15 are dependent on claim 13 which is dependent on amended claim 12, and recites further features with respect to amended claim 12. As stated above with respect to claim 13, Herwig and Tsai together do not show a power supply being coupled to a bus hub to supply power to the bus hub as is recited in amended claim 12. Neither Decuir nor Sanchez show a power supply being coupled to a bus hub as is recited in amended claim 12. Therefore, even as combined, Herwig and Tsai combined with Decuir or Sanchez do not show all of the features recited in claims 14 and 15.

In addition, the Office Action has not cited evidence of record in support of a motivation to combine Herwig and Tsai as is required by *In re Vaeck*, and *In re Lee*. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 14 and 15, and that claims 14 and 15 are in condition for allowance.

Claims 21-23 were rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Tsai. The applicant respectfully traverses.

The Office Action States that “it would have been obvious.....to have implemented said cable, as disclosed by Herwig, in said cable system, as disclosed by Tsai, for the advantage of providing a compact and clean wiring in said housing, which is a common sense to one of ordinary skill in the art of electronics wiring.” Office Action, page 11. The Office Action has not cited evidence of record in support of this motivation to combine Herwig and Tsai as is required by *In re Vaeck*, and *In re Lee*. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 21-23, and that claims 21-23 are in condition for allowance.

Claim 26 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Tsai and Decuir. Claim 27 was rejected under 35 USC § 103(a) as being unpatentable over Herwig in view of Tsai and Sanchez. The applicant respectfully traverses.

Claims 26 and 27 are dependent on claim 21, and recite further features with respect to claim 21. The Office Action did not cite evidence of record in support of a motivation to combine Herwig and Tsai as is required by *In re Vaeck*, and *In re Lee*. The applicant respectfully submits that the Office Action has not established a *prima facie* case of obviousness of claims 26 and 27, and that claims 26 and 27 are in condition for allowance.

**CONCLUSION**

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

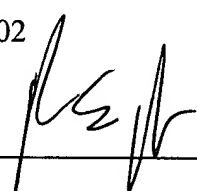
Respectfully submitted,

BRIAN A. LEETE

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
Attorneys for Intel Corporation  
P.O. Box 2938  
Minneapolis, Minnesota 55402  
(612) 373-6973

Date 14 JUNE 2004

By   
Robert E. Mates  
Reg. No. 35,271

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 14th day of June 2004.

KACIA LEE  
Name

Kacia Lee  
Signature